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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of

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See Yap ONG et al.

Date: October 14, 2003

TC 1700

Serial No.: 10/013,079

Group Art Unit: 1732

Filed: December 11, 2001

Examiner: Angela Y. Ortiz

For: METHODS AND APPARATUS FOR CLEANING AN IC ENCAPSULATION  
SYSTEM

#5/a  
VDE

10/23/03

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE

Sir:

Claim Amendments appear herein.

Responsive to the Restriction Requirement mailed September 23, 2003, Applicant elects Group I, claims 1-11 drawn to the method. The Restriction Requirement is respectfully traversed.

The elected method claims 1, 2, and 3 correspond respectively in structural elements to the product claims 12 or 15, 13 or 16 and 14 or 17. Correspondence between method claim 9 and product claim 20, between method claim 10 and product claim 21, and between method claim 11 and product claim 22 may be found.

The issue is whether the processes claimed can be practiced by another materially different apparatus or that the apparatus can practice another materially different process. The statement in the Requirement that such material difference can be found in the present claims is not correct. Turning to specific statement made in the Restriction Requirement, the apparatus cannot practice on pellets of a material that is not plastic because every claim recites pellets of plastic material, whereby any system or method not involving pellets of plastic material would not be covered by the claim. It is not agreed that the process can be practiced by a materially different apparatus than as claimed, since at least not all of the claims concern the nature of the

structure that receives the lead frame items and consequently whether or not multiple cavities are provided does not fall within all claims subject to election. The inventions are not distinct and because of the analog between each method element and each product element in the claims, it is submitted that they should be examined together. As the claims are currently worded, a search as to one of the inventions necessarily would involve a search for the other inventions. To omit searching in the area where either of the inventions is classified would be less than a thorough search.

As noted in MPEP 806.05(e), the Examiner has not met the burden of providing a reasonable example that recites the material differences, but rather has not considered the claim language in citing the differences. It is believed that all of the claims should be examined together and that there are neither materially different processes nor materially different apparatus as between the two groups of claims.

It is submitted that the inventions are not independent because there is a clear relationship between the process and the apparatus that may be used and that performs the process. Further, it is submitted that the inventions of process and apparatus are both related as disclosed and are not distinct as claimed. The process will be performed by the apparatus and the apparatus will perform the process. MPEP 802.01 makes it clear that the two inventions must be both independent and distinct. The inventions are clearly not independent and it is submitted they are not distinct either. Reconsideration and withdrawal of the Restriction Requirement is requested.

The objections to claims 2 and 14 are noted and have been addressed in the Amendments hereto. The spelling error in claim 2 has been corrected. The correction of the word "system" in the preamble of claim 14 makes that claim a proper dependent claim. Claim 12 has a typing error corrected herein.

#### **CONTINGENT EXTENSION REQUEST**

If this communication is filed after the shortened statutory time period had elapsed and no separate Petition is enclosed, the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. § 1.136(a), to extend the time for filing a response to the outstanding Office Action by

the number of months which will avoid abandonment under 37 C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 15-0700.

**SUMMARY OF AMENDMENTS**

1. ☐ If checked, an abstract (an amended abstract) is submitted herewith.
2. ☐ If checked, amendment(s) to the drawings are submitted herewith.
3. ☐ If checked, amendment(s) to the specification are submitted herewith.
4. ☒ If checked, amendment(s) to the claims are submitted herewith.